

REMARKS

I. Petition Under 37 C.F.R. § 1.136(a)

Pursuant to 37 C.F.R. § 1.136(a), applicants hereby petitions for a three-month extension of the shortened statutory period set for reply to the Office Action dated December 4, 2006. The Commissioner is authorized to charge the \$1020.00 fee set forth in 37 C.F.R. § 1.17(a)(3) or any other fees which may be required or credit any overpayment to Deposit Account No. 50-0369.

II. Introduction

Claims 39-144 are pending in this application.

Claims 39-144 are rejected.

Applicants traverse these rejections based on the amendments above and the remarks set forth below. Applicants respectfully request reconsideration and allowance of the pending claims.

III. Applicant's Reply to Rejections Under 35 U.S.C. § 102

Claims 132-134, 137-141, and 144 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Pat. No. 5,636,276 to Brugger ("Brugger"). Applicant respectfully traverses.

One aspect of applicant's invention is directed toward a computer-based library system that employs authentication and encryption protocols for the secure transfer of content to a client computer system and a mobile playback device. The mobile playback device is removably connectable to the client computer system. This novel system includes a library and information delivery system for accessing and obtaining selected digital information files. The library and information delivery system generally includes a library server having a plurality of digital information files and a client computer system coupled to the library server over a network. Also included is one or more mobile devices removably connectable to the client computer system. The client computer system includes logic for requesting a download of one or more selected digital information files from the library server and further includes targeting logic for downloading the selected digital information files to a specific mobile device.

Thus, for example, in operation, selected digital content files may be selected by a user and downloaded from the library server to a specific mobile playback device based on targeting information in a targeting header. In one embodiment, a client computer may receive the user requested information and generate the targeting header for transferring selected content to a one

or more mobile playback devices removably connected to the client computer. In other embodiments, the mobile playback device may connect substantially directly to library server via a wireless link to receive the selected information. In this case, the targeting header and subsequent information transfer may be handled by a computing system associated with the library server. After the selected information is received by the mobile playback device, the mobile playback device may perform certain authentication procedures to ensure the playback device is authorized to play the received content (e.g., by comparing information in the targeting header with information in the playback device, such as device ID, etc.). Independent claims 39, 53, 56, 59, 72, 86, 110, 132 and 139 have been variously amended to more specifically point out and describe these novel features. Thus, applicant's claimed invention provides a robust and secure system for the transfer and reception of electronic information.

In contrast, Brugger fails to show or suggest these features anywhere. For example, as shown in FIG. 1 of Brugger and as explained at column 6, lines 25-40, Brugger merely employs a system wherein music information is sent from a central memory device 2 to a terminal 6, which plays the received information and transmits it to "dumb" reproduction

devices 44, 46 and 48, all of which are coupled to one another through fixed interconnection. Thus, the system of Brugger does not show or suggest the mobile playback device specified as in applicant's amended claims, nor does it show or suggest the use of targeted headers for specifying a certain mobile playback device to receive certain selected content. Similarly, Brugger does not mention the use of such targeted headers in mobile playback devices as an authentication mechanism as specified in applicant's claims. Accordingly, applicants respectfully submit the pending claims, as amended, are allowable over Brugger.

IV. Applicant's Reply to Rejections Under 35 U.S.C. § 103

Claims 39-131 are rejected under 35 U.S.C. §103 (a) as being unpatentable over Brugger in view of U.S. Patent No. 5,761,485 to Munyan ("Munyan"). Applicant respectfully traverses.

As explained above, one reason the pending claims are patentable over Brugger is because Brugger does not disclose generating a targeted header for a mobile playback device or authenticating content on mobile device based on information associated with the targeted header. Munyan also fails to disclose these features. Because both Munyan and Brugger both fail to show to suggest these features, the Examiner's proposed

combination therefore also fails. See, for example, *Gentry Gallery, Inc. v. Berkline Corp.* 134 F.3d 1473, 45 USPQ2d 1498 (CAFC 1998). Accordingly, applicant respectfully submits claims 39-131 are patentable over the Examiner's proposed combination of Brugger and Munyan for at least the same reasons.

Not Obvious to Combine

Furthermore, applicants submit it is not obvious to combine the references as proposed by the Examiner. This is true for at least several reasons. For example, there is no motivation provided in the references themselves suggesting such a combination. The Examiner has mentioned that such motivation may be "found in the knowledge generally available to one of ordinary skill in the art" (Office Action at 3). However, the level of skill in the art *cannot* be relied upon to provide the suggestion to combine references. See, for example *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) and MPEP § 2143. In addition, the Examiner has made no finding of a specific understanding within the knowledge of a skilled artisan that would motivate one with no knowledge of the invention to arrive at the claimed limitation. See, for example, *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000). Thus, the proposed combination is improper.

Moreover, applicants point out that substantial modification of Brugger would be required to accommodate the features of Munyan and as proposed by the Examiner. No teaching is provided by either reference describing how to accomplish such modifications, further discouraging their combination. Further, the hardwired dumb terminal playback system of Brugger teaches away from the personal electronic book described in Munyan.

Additionally, based on the above, applicants further submit that the Examiner's proposed combination is based on impermissible hindsight reconstruction, as the Examiner is merely picking and choosing from among the limitations in the references to produce the claimed invention. See, for example, *ATD Corp. v. Lydall, Inc.* 48 USPQ2d 1321 (Fed. Cir. 1998) "Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the invention." Thus, the proposed combination is improper.

Accordingly, applicant requests that the obviousness rejection be withdrawn.

V. Applicants' Reply of 9/1/06

Although certain claims have been amended herein in an effort to expedite prosecution of this case by further pointing out and more particularly defining the present inventions,

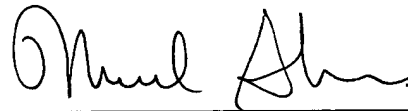
applicants hereby reincorporate by reference all of the arguments offered in the reply of 9/1/06 which are still believed to demonstrate patentable distinctions over the current rejections (which are essentially the same as the previous rejection). Applicants reserve the right to present any of those arguments in any subsequent appeal that may occur in this case.

VI. Conclusion

For the foregoing reasons, Applicant respectfully submits that the invention as claimed is patentable over the references cited by the Examiner. Accordingly, reconsideration and allowance of pending claims 39-144 are respectfully requested. The Examiner is encouraged to contact Applicant's undersigned representative to discuss any matter that may expedite prosecution of this case.

Respectfully submitted,

Date: 6/4/07



Michael E. Shanahan
Registration No. 43,914
Customer No. 21710
Attorney for Applicants
BROWN RUDNICK BERLACK ISRAELS LLP
Seven Times Square
New York, New York 10036
212-209-4978
212-209-4801